IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JMason
12/26/02

Attorney Docket No: 032931/0256

In re patent application of
MURDIN, Andrew D. *et al.*

Serial No.: 09/869,433

Group Art Unit: 1645

PCT filing date: December 22, 1999

Examiner: Padmavathi Baskar

U.S. filing date: October 16, 2001

For: CHLAMYDIA ANTIGENS AND CORRESPONDING DNA FRAGMENTS AND USES THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Restriction Requirement mailed October 4, 2002, Applicants hereby elect the claims of Group I (claims 44-62, 79 and 83), drawn to DNA, vector, host cell, vaccine, pharmaceutical composition and a method for preventing Chlamydia infection, for prosecution in the subject application, **with traverse**. Applicants provisionally elect SEQ ID NO:1 for examination, **with traverse**.

The Examiner has alleged that the claims of Groups I-V do not relate to a single inventive concept under PCT Rule 13.1, and that SEQ ID NOs: 1 and 2 lack the same or corresponding special technical features required for unity under PCT Rule 13.2. Applicants respectfully disagree.

(a) The DNA and the polypeptide have the same essential structural element

Applicants maintain that the polypeptide of SEQ ID No: 2 and a nucleic acid encoding it constitute a single inventive concept. Annex B of the Administrative Instructions Under the PCT describes three particular situations for which the method for determining unity of invention contained in Rule 13.2 is explained in detail. One

particular situation describes the relationship between intermediate and final products, as follows:

> (g) Intermediate and Final Product. The situation involving intermediate and final products is also governed by Rule 13.2.
> (i) The term "intermediate" is intended to mean intermediate or starting products. Such products have the ability to be used to produce final products having the ability to be used to produce final products through a physical or chemical change in which the intermediate loses its identity.
> (ii) Unity of invention shall be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:
> (A) the intermediate and final products have the same essential structural elements, in that:
> (1) the basic chemical structures of the intermediate and the final products are the same, or
> (2) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and
> (B) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

A nucleic acid and the polypeptide it encodes are starting products and final products. There is unity because the DNA and the polypeptide have the same essential structural element, namely that both products share the same polymeric sequence. While nucleic acids and polypeptides are chemically different, the claimed nucleic acids and polypeptides share the same sequence structure, since the initiator codon is described and the nucleic acid sequence is understood to be read in triplets. Applicants draw the Examiner's attention to part (f)(ii) of the Administrative Instructions, which states that "the structural element may be a single component or a combination of individual components linked together".

(b) Example 17 of Annex B states that there is unity between protein and DNA

The Examiner is directed to Example 17 of Annex B of the Administrative Instructions Under the PCT. Example 17 states that there is unity between a claim to

protein X and a claim to DNA sequence encoding protein X because the protein and the DNA sequence exhibit corresponding special technical features.

In consideration of the above, Applicants submit that the claims of Group I (claims 44-62, 79 and 83) and Group II (claims 63-68, 70-79, 84 and 85) should be joined.

(c) The polypeptide and its corresponding antibody share a special technical feature

The Examiner is directed to Example 8 of Annex B of the Administrative Instructions Under the PCT. Example 8 states that there is a special technical feature included in a claim to a plug characterized by feature A and a claim to a socket characterized by corresponding feature A, and that there is unity between these claims. The correspondence between a plug and its socket is equivalent to the correspondence between a protein and an antibody binding to it.

In consideration of the above, Applicants submit that the claims of Group II (claims 63-68, 70-79, 84 and 85) and Group III (claims 69 and 79) should be joined.

(d) The protein/DNA, methods of manufacturing them and methods of using them share a special technical feature

The Examiner is directed to Example 1 of Annex B of the Administrative Instructions Under the PCT. Example 1 states that there is a special technical feature (substance X) between three categories of claims: (a) a claim to substance X; (b) a claim to a method of manufacturing substance X; and (c) a claim to the use of substance X, and states that the claims therefore have unity.

The claims of Groups IV and V (claims 80-82) are drawn to specific uses of the protein and DNA. The protein/DNA is the special technical feature between these claims and the claims of Groups I and II. Applicants submit that the claims of Groups

IV and V (claims 80-82), and the claims of Groups I and II (claims 44-68, 70-79 and 83-85) should be joined.

(e) Burden of search

It is respectfully submitted that by this Response, the subject matter of the claims is sufficiently related that a thorough search of the subject matter of any one single independent claim would necessarily encompass a search for the subject matter of the remaining claims.

Thus, it is respectfully submitted that the search and examination of the entire application could be performed without serious burden. MPEP §803 clearly states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants in duplicative examination by the Patent Office.

Concluding remarks

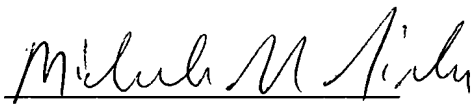
The Examiner is respectfully requested to reconsider and withdraw the Restriction Requirement and to examine all the claims now pending in this application.

In accordance with this election with traverse, applicants reserve all rights in the non-elected claims, including the right to file one or more divisional applications covering the subject matter thereof.

If there are any fees due in connection with the filing of this Amendment, please charge the fees to Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: December 20, 2002



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